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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/510,989	10/13/2004	Bruno Bret	935.44285X00	2221
20457 7590 08/13/2007 ANTONELLI, TERRY, STOUT & KRAUS, LLP 1300 NORTH SEVENTEENTH STREET SUITE 1800 ARLINGTON, VA 22209-3873			EXAMINER HAND, MELANIE JO	
			ART UNIT 3761	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/510,989

Applicant(s)

BRET ET AL.

Examiner

Melanie J. Hand

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3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims 21-31 have been considered but are moot in view of the cancellation of the claims.

In response to applicant's argument that Sine teaches zinc gluconate as a component to control odors and not for imparting antimicrobial property to a substrate, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

With respect to applicant's argument that Sine does not teach a substrate of paper fibers of nonwoven type, and that the incorporation by reference to Thaman does not remedy this deficiency because it is directed to a medicated cleansing pad, Applicant is directed to Col. 3, lines 26 and 27, in which Thaman teaches that the fibers of the substrate are wood pulp (i.e. paper) fibers, and lines 19-25, in which Thaman teaches that the fibers are arranged into a web via a paper-making machine (i.e. the substrate is based on paper fibers and is of a non-woven type). The fact that the invention of Thaman is directed to a medicated cleansing pad is immaterial as Sine has incorporated the Thaman reference in its entirety. (see Sine, Col. 16, lines 36-51)

As to applicant's argument that Sine does not teach the quantity of zinc gluconate to be incorporated into the instant composition, applicant is referred to Col. 12, lines 60-63 where Sine teaches by reference to Beerse et al, WO 98/55080, an antimicrobial composition which comprises 0.1-1% antimicrobial active by weight of the full antimicrobial agent composition, wherein the antimicrobial active is a zinc salt ('080, Page 8, ¶12).

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As to applicant's argument that Sine does not teach a quantity of antimicrobial agent based upon the weight of the substrate, applicant is referred to Col. 12, lines 12-16 where Sine teaches that the antimicrobial agent is present in an amount between 0.05-0.5% by weight of the composition. The lower and upper limits of this range will necessarily be less than 0.05 and 0.5, respectively, when the weight percentage of the antimicrobial agent is based upon the weight of the substrate, because the substrate has a greater weight than the composition.

As to applicant's argument that Sine does not teach a substrate obtained by a dry method comprising a thermoplastic binder and an antimicrobial agent as claimed, the limitation of "obtained by a dry method" constitutes product-by-process claim language given little patentable weight herein, because the claims are directed to an article. Further, applicant is directed to Col. 4, lines 44-60 of Thaman (incorporated by reference by Sine) wherein Thaman teaches that the binder resin of the instant invention is a styrene-butadiene resin which is a synthetic latex, which meets the relevant claim limitation (claim 35). As to applicant's arguments regarding quantity of antimicrobial, these have been addressed *supra*.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the quantity of claimed antimicrobial agent to incorporated into the substrate to have in the final product an efficient quantity of zinc gluconate to enable the gluconate to have an antimicrobial effect per se) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The Sine reference, alone or by reference to Thaman, teaches or fairly suggests the claimed invention and thus, if this limitation were claimed, the limitation would flow necessarily from the teachings of Sine.

Claim Rejections - 35 USC § 102/103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 32-35 and 37-41 are rejected under 35 U.S.C. 103(a) as obvious over Sine et al. (US 6,183,766).

With respect to **claim 32**: Sine teaches by reference to Thaman (U.S. Patent No. 4,891,277) a substrate based on paper fibres of a non-woven type, comprising a thermoplastic binder comprising a styrene-butadiene binder resin (which is thermoplastic by nature) enabling the fibres to bind together and an antimicrobial agent, namely zinc gluconates. Sine teaches by an additional reference to Beerse (WO 98/55080 A2) an antimicrobial agent being present in an antimicrobial composition in a range of 0.5-2% ('080, Page 4, ¶15) that overlaps a range disclosed by applicant (0.05-1% by weight of antimicrobial agent) for the same weight basis (i.e. weight % by weight of antimicrobial agent) and Sine by reference to Thaman meets all of the claim limitations of claim 32. Thus, the range set forth in claim 32 for weight % of antimicrobial agent by weight of substrate is considered herein to be an inherent property of Sine by reference to Thaman and Beerse and the claimed invention. When the structure or composition recited in the reference is substantially identical to that of the claims of the instant invention, claimed properties or functions presumed to be inherent (MPEP 2112-2112.01). A prima facie case of either anticipation or obviousness has been established when the reference discloses all the limitations of a claim (in this case, a substrate of paper fibers of nonwoven type comprising an antimicrobial agent) except for a property or function (in the present case, a percent by weight of antimicrobial agent based upon weight of the substrate) and the examiner can not determine whether or not the reference inherently possesses properties that anticipate

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or render obvious the claimed invention but has a basis for shifting the burden of proof to applicant, as per *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980).

The limitation "thereby conferring antimicrobial properties to said substrate" constitutes functional language that is given little patentable weight herein. The limitation "obtained by a dry method" constitutes product-by-process claim language that is given little patentable weight herein. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985). See also MPEP § 2113. The burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983)

With respect to **claim 33**: Sine teaches by reference to Thaman and Beerse that said substrate comprises 0.05 to 2% by weight of said antimicrobial agent. ('080, Page 4, ¶15 – Page 5, ¶1)

With respect to **claim 34**: Sine teaches a zinc salt as antimicrobial agent and teaches zinc gluconate as an odor control agent. Since it is clear to one of ordinary skill in the art that bacteria causes odor, though Sine does not explicitly teach zinc gluconate as the zinc salt of the antimicrobial agent, it would be obvious to one of ordinary skill in the art to modify the composition of Sine such that the zinc salt of the antimicrobial agent is zinc gluconate with a reasonable expectation of success. ('766, Col. 12, lines 37-44)

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With respect to **claim 35**: The thermoplastic binder taught by Sine by reference to Thaman is styrene-butadiene, which is a synthetic latex. ('227, Col. 4, lines 57-61)

Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sine ('766) in view of Bundo et al (U.S. Patent Application Publication No. 2003/0099828).

With respect to **claim 36**: Sine by reference to Thaman does not teach a thermoplastic binder that is ethylene vinyl acetate copolymer. Bundo teaches a multilayer substrate comprising an antimicrobial agent. Bundo teaches that either a styrene-butadiene resin binder or ethylene vinyl acetate copolymer binder can be used. Since Bundo teaches that the two are equivalents and teaches a device which seeks to solve a similar problem in the art it would be obvious to one of ordinary skill in the art to modify to article taught by Sine by reference to Thaman such that the binder comprises ethylene vinyl acetate copolymer with a reasonable expectation of success. ('828, ¶0112)

With respect to **claim 37**: Sine by reference to Thaman does not teach that the antimicrobial agent is incorporated within said substrate by spraying a liquid mixture comprising said thermoplastic binder and said antimicrobial agent on to the substrate or by impregnation or induction of said substrate with said mixture. However these limitations constitute product-by-process limitations that are given little patentable weight herein. See *In re Fitzgerald, Sanders, & Bagheri*, 205 USPQ 594 (CCPA 1980).

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With respect to **claim 38**: Sine teaches by reference to Thaman a medicated cleansing pad, considered herein to be a sanitary article. ('227, Abstract)

With respect to **claim 39**: Sine teaches by reference to Thaman an absorbing paper by teaching that the substrate is comprised of wood pulp, or paper fibers. (Col. 3, lines 26,27)

With respect to **claim 40**: The limitation of claim 40 is considered herein to be directed to an intended use of the claimed invention and is thus given little patentable weight herein. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

With respect to **claim 41**: The limitation of claim 41 is considered herein to be directed to an intended use of the claimed invention and is thus given little patentable weight herein. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Conclusion

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie J. Hand whose telephone number is 571-272-6464. The examiner can normally be reached on Mon-Thurs 8:00-5:30, alternate Fridays 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tatyana Zalukaeva can be reached on 571-272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Melanie J Hand
Examiner
Art Unit 3761

August 3, 2007

TATYANA ZALUKAEVA
SUPERVISORY PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read 'Tatyana', written over the printed name and title.